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10/563,326	05/10/2006	Delphine Blanc-Magnard	0070681-000037	6749
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EXAMINER				
OJURONGBE, OLATUNDE S				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
12/02/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

# Office Action Summary

**Application No.**

10/563,326

**Applicant(s)**

BLANC-MAGNARD ET AL.

**Examiner**

OLATUNDE S. OJURONGBE

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.  
4a) Of the above claim(s) 3 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 2, 4 and 12 is/are rejected.  
7) ☒ Claim(s) 5-11 and 13-32 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SI/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's election of species (ii), claims 1-2 and 4-32 in the reply filed on 12 September, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the election of species requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. The election of species requirement for the organosiloxane A is withdrawn.

### ***Specification***

3. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
- (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
  - (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(I) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### ***Claim Objections***

4. **Claims 5-11,13-32** are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n).

Accordingly, the claims 5-11 and 13-32 have not been further treated on the merits.

The claims refers to preceding claims that include claim 4, claim 4 is a multiple dependent claim.

Further, claims 17-24 recite "The composition as claimed in one of the preceding claims..", this is an improper form of multiple dependent claim.

**Claim 16** is objected to because of the following informalities: Claim 16 recites that limitation "...A possessing reactive SiH units have at least one unit of formula (II) and are terminated by units of formula (III) or are cyclic and are composed of units of formula (II) represented below....", the claim further defines the symbol Z, the corresponding formula (II) and formula (III) in the specification discloses Z' instead of Z (see instant specification, page 11).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-2, 4 and 12** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "...characterized in that the catalytic complex C is an iridium complex capable of being obtained by reacting together : C1, on the one hand, an iridium complex of formula (I).....C2, on the other hand, a ligand  $\sigma_d$ ....."; it is unclear what the product of the reaction C is. For proper examination, the product of the reaction C1 and the ligand  $\sigma_d$  should be specified.

Also in claim 1, the term "capable of being obtained by..." is indefinite since capable means it is able to be obtained in this manner, but is this an actual requirement? Does this limit the claim to reacting of the two compounds or is this just one manner in which the complex is able to be obtained. This also ties into the fact that it is unclear what the catalytic complex C is.

Further the definitions of L and X are missing in the "...if n is .." claim limitation, as the language "preferably....", reflects on a preferred limitation and not an actual, limiting definition.

The claim further recites "...2/ $\sigma$ ", which are identical or different, each represent a 2-electron ligand L chosen in particular....", it is unclear what is meant by "chosen in particular"; is this a definitive limitation or a preferred limitation? Does the same meaning apply to its use in the definition of H-Si bond?

Further there is no definition for the R term in the claim.

Dependent claims 2, 4 and 12 are rejected for the same reason.

Same problem as explained above for sigma' of claim 1 exist for sigma of claim 2.

Further claim 2 recites "...second unit..", it is unclear what is meant by second unit as it appears in the claim.

For claim 12, what is embraced by this claim is confusing. That is, in claim 1, the complex is obtained by reacting but claim 12 requires only mixing. Are mixing and reacting considered to be the same?

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 1-2, 4 and 12** are rejected under 35 U.S.C. 103(a) as being obvious over **Benayoun et al (US 6,875,516)**.

The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art

only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding **claim 1**, Benayoun et al teaches an SiH/SiOH silicone composition polymerizable/crosslinkable by dehydrogenating condensation in the presence of a catalyst, the composition comprising (A), at least one SiH POS; (B) at least one SiOH POS; (C) at least one metal catalyst selected from the group of organometallic complexes comprising at least one of Ir, Ru, Mn (abstract). Benayoun et al further exemplifies the catalyst of the invention to include  $[\text{IrCl}(\text{cyclooctene})_2]_2$  (see Table II, col.19, lines 25-40).

The  $[\text{IrCl}(\text{cyclooctene})_2]_2$  of Benayoun et al serves as the C1 of the instant claim. Though Benayoun et al does not teach a silicone composition which can be crosslinked by dehydrogenative condensation, characterized in that the catalytic complex C, is an

iridium complex capable of being obtained by reacting together C1, on one hand, C2 on the other hand of the instant claim, Benayoun et al further teaches that iridium-based complexes having  $\text{PPh}_3$ , CO and Cl radicals are particularly preferred because the complexes have proved to be particularly remarkable in terms of cost/reactivity (col.4, lines 50-67); since the exemplified iridium-based catalyst of Benayoun et al are limited, one of ordinary skill in the art, motivated by the remarkable reactivity of the iridium-based complexes having  $\text{PPh}_3$ , CO and Cl radicals would have formed various iridium-based catalysts by reacting one or more of  $\text{PPh}_3$ , CO and Cl with other iridium-based complexes of Benayoun et al ( this includes the reaction of  $[\text{IrCl}(\text{cyclooctene})_2]_2$  and  $\text{PPh}_3$ ), by routine experimentation.

$\text{PPh}_3$  of modified Benayoun et al serves as C2, a ligand sigma<sub>4</sub> of the instant claim.

Regarding **claim 2**, the  $[\text{IrCl}(\text{cyclooctene})_2]_2$  of modified Benayoun et al is dimeric and the structure of formula (I') is one of the isomeric structures of the complex.

Regarding **claim 4**, the  $[\text{IrCl}(\text{cyclooctene})_2]_2$  complex of modified Benayoun et al, corresponds to formula (I) of the instant claim, wherein n is 2 and the sigma ligand is chloro.

Regarding **claim 12**, though modified Benayoun et al does not teach the composition of the instant claim characterized in that the catalytic complex C is the product of the mixing of bis (1,5-cyclooctadiene)diiridium (I) dichloride and of triphenyl phosphine,



since modified Benayoun et al further teaches complexes with cod (1,5-cyclooctadiene) (see  $\text{Ir}(\text{P}(\text{cyclo})_3)(\text{cod})(\text{pyr})]^+ \text{PF}_6^-$ , Table II, col.19, line 35), one of ordinary skill in the art would have formed the complex  $[\text{IrCl}(\text{cyclooctene})_2]_2$  of modified Benayoun et al using 1,5-cyclooctadiene instead of cyclooctene by routine experimentation, with a reasonable expectation of success; a *prima facie* case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities.

### **Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLATUNDE S. OJURONGBE whose telephone number is (571)270-3876. The examiner can normally be reached on Monday-Thursday, 7.15am-4.45pm, EST time, Alt Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571)272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

O.S.O.

/Margaret G. Moore/  
Primary Examiner, Art Unit 1796  
mgm  
11/24/08